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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,057	08/01/2001	Valtteri Nicmi	324-010477-US (PAR)	4430
2512	7590	10/16/2006	EXAMINER	
PERMAN & GREEN 425 POST ROAD FAIRFIELD, CT 06824			DAVIS, ZACHARY A	
			ART UNIT	PAPER NUMBER
			2137	

DATE MAILED: 10/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center"><b>Office Action Summary</b></p>	Application No. 09/920,057	Applicant(s) NIEMI ET AL.	
	Examiner Zachary A. Davis	Art Unit 2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 11, 12, 17-24, 27, 28, 33-40, 43 and 44 is/are rejected.
- 7) ☒ Claim(s) 9, 10, 13-16, 25, 26, 29-32, 41, 42 and 45-48 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

1. A response was received on 10 August 2006. By this response, no claims have been amended, added, or canceled. Claims 1-48 are currently pending in the present application.

### ***Response to Arguments***

2. Applicant's arguments filed 10 August 2006 have been fully considered but they are not persuasive.

In reference to the rejection of Claims 1-8, 11, 12, 17-24, 27, 28, 33-40, 43, and 44 under 35 U.S.C. 102(a) or (e) as anticipated by Fauconnier, US Patent 6768903, and the disclosures therein referring to technical specifications published by the 3<sup>rd</sup> Generation Partnership Project, Applicant argues that one of the technical specifications, namely 3G TS 25.832, version 3.0.0, does not disclose the claimed subject matter as described by Fauconnier.

In particular, Applicant argues that the technical specification only shows handover between UTRAN and GSM/GPRS and does not show what Fauconnier describes as using "the same ciphering procedures" (see page 14 of the present response, citing section 5.7 of 3G TS 25.832, and Fauconnier at column 4, lines 61-67). However, the Examiner believes that the disclosure in the technical specification inherently includes the capability of using the same encryption algorithm, or, as

Fauconnier states, "making it possible ... to use the same ciphering procedures, such as a system of the GERAN type". The ciphering procedures described as above in Fauconnier, corresponding to the claimed encryption algorithm and parameters, are an inherent part and capability of the GERAN system (corresponding to the GSM/GPRS system in the technical specification, and the claimed packet-switched TDMA system). The Examiner believes that it is an inherent feature of handover that if encryption (i.e. ciphering) is used in one of the systems between which the handover is taking place, then, in order to maintain the security of the communication, encryption would be used in the other system, and that it would inherently be simplest to use the same ciphering procedures, as Fauconnier describes in relation to the disclosure of the technical specification at column 4, lines 46-67 (especially lines 61-67). Therefore, contrary to Applicant's assertion, the Examiner believes that Fauconnier's disclosure of a hard handover taking place between separate access networks using the same ciphering procedures is not speculation, but is instead the simplest inherent procedure to follow when performing a handover as described in the technical specification.

Therefore, for the reasons detailed above, the Examiner maintains the rejection as set forth below.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-8, 11, 12, 17-24, 27, 28, 33-40, 43, and 44 are rejected under 35

U.S.C. 102(a) or (e) as being anticipated by Fauconnier, US Patent 6768903, noting

that the portions relied upon further cite back to technical specifications published by the 3<sup>rd</sup> Generation Partnership Project, specifically: 3G TS 25.301, version 3.4.0, published March 2000; 3G TS 25.401, version 3.1.0, published January 2000; 3G TS 25.331, version 3.1.0, published October 1999; 3G TS 25.322, version 3.2.0, published March 2000; 3G TS 25.321, version 3.3.0, published March 2000; 3G TS 25.212, version 3.0.0, published October 1999; and 3G TS 25.832, version 3.0.0, published October 1999.

In reference to Claim 1, Fauconnier discloses a method for transmitting data between a network using packet-switched TDMA and a user mobile equipment, that includes encrypting data to be transmitted, transmitting the encrypted data, and deciphering the transmitted data (see column 3, line 63-column 4, line 2), and in which the encryption algorithm of a network using wideband CDMA is used with parameters adapted to parameters of the packet-switched TDMA network (see column 4, lines 61-67, where it is possible to use the same ciphering procedures in a UTRAN and a GERAN).

In reference to Claim 2, Fauconnier further discloses that a format of the parameters includes a number and length of each parameter (column 4, lines 5-16).

In reference to Claim 3, Fauconnier further discloses that the implementation of the encryption algorithm is the same in both the packet-switched TDMA network and the wideband CDMA network (column 4, lines 61-67).

In reference to Claims 4 and 5, Fauconnier further discloses a counter parameter (column 4, lines 8-9).

In reference to Claim 6, Fauconnier further discloses the use of a bearer parameter (column 4, lines 10-11).

In reference to Claims 7, 8, 11, and 12, Fauconnier further discloses that the encryption algorithm can be executed in either the MAC layer or the RLC layer (column 5, lines 37-41), and that the counter parameter includes a frame number (column 5, lines 49-54).

Claims 17-24, 27, and 28 are directed to an apparatus, specifically user equipment, that corresponds substantially to the method of Claims 1-8, 11, and 12, and are rejected by a similar rationale.

Claims 33-40, 43, and 44 are directed to an apparatus, specifically a radio access network, that corresponds substantially to the method of Claims 1-8, 11, and 12, and are rejected by a similar rationale.

***Allowable Subject Matter***

5. Claims 9, 10, 13-16, 25, 26, 29-32, 41, 42, and 45-48 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
6. Reasons for indicating allowable subject matter were set forth in the previous Office action.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
  - a. A copy of Technical Specification 3G TR 25.832 version 3.0.0, "Manifestations of Handover and SNRNS Relocation", as cited by Fauconnier, is included herewith.
8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachary A. Davis whose telephone number is (571) 272-3870. The examiner can normally be reached on weekdays 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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EMMANUEL L. MOISE  
SUPERVISORY PATENT EXAMINER